

### **REMARKS**

This responds to the Office Action mailed on March 21, 2006.

No claims are amended, canceled, or added. As a result, claims 1-30 are now pending in this application.

For the convenience of the Examiner, Applicant's remarks concerning the claims will be presented in the same order in which the Examiner presented them in the Office Action.

### **Double Patenting Rejections**

Claims 1-8, 10, and 11 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10, respectively, of U.S. Patent 6,622,802.

Claims 9, 20, and 29 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 11, and 21, respectively, of U.S. Patent 6,622,802.

Claims 17 was rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 16 of U.S. Patent 6,622,802.

Claims 12-16, 18, 19, 21, and 22 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-15 and 17-20, respectively, of U.S. Patent 6,622,802.

Claims 23-28 and 30 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-27, respectively, of U.S. Patent 6,622,802.

Accordingly, Applicant is filing herewith a terminal disclaimer in compliance with 37 CFR 1.321 (c) and 37 CFR 3.73(b).

**Rejection of Claims 1-5, 12-16, 21, and 23-25**  
**Under 35 U.S.C. §103(a)**  
**As Being Unpatentable over Tanaka in View of Maier**

Claims 1-5, 12-16, 21, and 23-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tanaka (U.S. 5,437,339) in view of Maier et al. (U.S. 4,213,301).

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the prior art reference (or references when combined) must teach or suggest every limitation of the claim. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA, 1974). MPEP §2143.

Tanaka discloses an air-pressure-operated nail gun having a cylinder 1 (FIG. 1) and a sub-cylinder 6. A piston 2 is movable within cylinder 1. Piston 2 has a physically integral driver 3 that is movable within nose assembly 4 to drive a nail. A weight piston 7 is movable within sub-cylinder 6. Weight piston 7 is in contact with a compression spring 8. When air is introduced into cylinder 1 and sub-cylinder 6 via an air supply inlet 9, piston 2 moves downward, and weight piston 7 moves upward. The upward reactive force generated by piston 2 moving downward is described as being offset by a downward force F2 on the shoulder 1' of sub-cylinder 6, causing the nail gun housing to be pushed against the work piece into which the nail is being driven (see column 5, line 46 through column 6, line 5).

Maier discloses an apparatus for driving fastening elements (see Abstract). The apparatus includes a double-headed piston 13 (FIG. 2, described in col. 5, lines 51-58) and a drive piston 5 (see col. 5, line 8) having a shaft 5b to contact a fastening element 15 (FIG. 3).

Neither Tanaka nor Maier, whether considered individually or in combination, discloses all of the claim limitations present in independent claims 1, 12, and 23.

For example, regarding independent claims 1 and 12, neither Tanaka nor Maier discloses a propulsion element (claim 1) or an air delivery infrastructure (claim 12) to propel the piston against the pin [emphasis added]. In Applicant's subject matter, the piston physically strikes the pin. Applicant could not find this disclosed in either reference.

Applicant respectfully asserts that the Examiner is apparently ignoring the limitation "propel the piston against the pin", because he hasn't mentioned or addressed that phrase in his "Response to Arguments".

Applicant further asserts that the limitation "to propel the piston against the pin" is not a method or functional limitation appearing within an apparatus claim. The limitation "to propel

the piston against the pin” defines a structural and geometrical relationship between the piston and the pin, namely, that the piston is capable of physically touching the pin.

In Tanaka, as the Examiner correctly observes, the pin 3 is not “physically independent of the piston” 2 (FIG. 1). Nor is the piston 2 propelled against the pin 3, because the piston 2 and pin 3 are coupled together (col. 5, lines 10-11).

In Maier, as the Examiner correctly points out, the pin 5 is “physically independent of the piston” 13. However, no part of the piston 13 contacts any part of the pin 5. The closest they get is shown in FIG. 3.

Further, the Examiner’s suggestion that “it would have been obvious to one skilled in the art to provide the tool of Tanaka with a pin physically independent of the piston in order to move more effectively within the channel to strike the workpiece” would result in a tool that is inoperable for the purposes for which it was intended, because if the pin 3 of Tanaka were made physically independent of the piston 2, when the piston 2 were returned to its upward position in cylinder 1, the pin 3 would fail to retract. Among other problems, the nail-supplying mechanism 19 (FIG. 2) would be prevented from working due to the presence of the pin 3 far down within the nose member 17.

Similarly, regarding independent claim 23, neither Tanaka nor Maier discloses an air delivery infrastructure to propel the primary hammer against a secondary hammer [emphasis added]. In Applicant’s subject matter, the primary hammer physically strikes the secondary hammer. Applicant could not find this disclosed in either reference.

The asserted combination of Tanaka in view of Maier fails to teach or suggest all of the claim limitations present in independent claims 1, 12, and 23, so a *prima facie* case of obviousness has not been established.

For these reasons, independent claims 1, 12, and 23 should be found to be allowable over Tanaka and Maier, and Applicant respectfully requests that the rejection of claims 1, 12, and 23 under 35 U.S.C. ' 103(a) as unpatentable over Tanaka in view of Maier be withdrawn.

Claims 2-5, 13-16, 21, and 24-25, which depend directly or indirectly from independent claims 1, 11, and 33, and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above.

**Rejection of Claims 11, 22, and 30**  
**Under 35 U.S.C. §103(a) As Being Unpatentable**  
**over Tanaka in View of Maier and Further in View of Lindsay**

Claims 11, 22, and 30 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Tanaka in view of Maier et al. and further in view of Lindsay (U.S. 6,095,256).

Tanaka and Maier were discussed above.

Lindsay discloses a hand-held pneumatic impact/engraving tool having a foot-operated control valve 88 (FIG. 17). The control valve 88 includes a barbed connector 114 to which a delivery line 38 to the tool 26 (FIG. 1) is coupled, and the control valve 88 further includes a barbed connector 116 to which a distribution line 32 (FIG. 1) from a pressure regulator assembly 20 may be connected.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the prior art reference (or references when combined) must teach or suggest every limitation of the claim. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA, 1974). MPEP §2143.

The asserted combination of Tanaka in view of Maier and Lindsay fails to teach or suggest all of the claim limitations present in independent claims 1, 12, and 23, so a *prima facie* case of obviousness has not been established.

Regarding independent claim 1, none of the three references discloses a propulsion element coupled to the body to propel the piston against the pin [emphasis added].

Further regarding independent claim 12, none of the three references discloses an air delivery infrastructure to propel the piston against the pin [emphasis added].

Regarding independent claim 23, none of the three references discloses an air delivery infrastructure to propel the primary hammer against a secondary hammer [emphasis added].

For these reasons, independent claims 1, 12, and 23 should be found to be allowable over Tanaka in view of Maier and Lindsay.

Claims 11, 22, and 30, which depend from independent claims 1, 12, and 23, respectively, and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above.

Applicant respectfully requests that the rejection of claims 11, 22, and 30 under 35 U.S.C. § 103(a) as unpatentable over Tanaka in view of Maier and Lindsay be withdrawn.

**Additional Elements and Limitations**

Applicant considers additional elements and limitations of claims 1-30 to further distinguish over the cited references, and Applicant reserves the right to present arguments to this effect at a later date.

**Conclusion**

Applicant respectfully submits that claims 1-30 are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Walter W. Nielsen (located in Phoenix, Arizona) at (602) 298-8920, or the below-signed attorney (located in Minneapolis, Minnesota) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

ALTON W. HEZELTINE

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, Minnesota 55402  
(612) 349-9592

Date April 21, 2006

By Ann M. McCrackin  
Ann M. McCrackin  
Reg. No. 42,858

**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 21 day of April, 2006.

Chris Hammond

Name

Chris Hammond

Signature